

**REMARKS**

In response to the Office Action mailed June 14, 2005, and the Office Action mailed February 24, 2005, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 5, 16-18 and 21 have been amended, claims 4, 19, and 20 have been withdrawn, and new claims 22-31 have been added.

**New Claims**

New claims 22-29 are dependent claims depending from claim 1 and have been added to further define the scope of the present invention. New dependent claims 22-29 do not add new matter and do not require a further search by the examiner. Accordingly, new claims 22-29 are in condition for immediate allowance.

New independent claim 30 and its dependent claim 31 have been added to provide a claim of narrower scope than claim 1 as presently amended. Since claim 30 is directed to the same subject matter claimed in claim 1 but only narrower in scope the examiner is not required to conduct a new search. Also new claims 30-31 are fully supported by the specification as originally filed and accordingly, no new matter is introduced.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

### **Specification Corrections**

The examiner has objected to the specification because of line spacing. In response to this objection a substitute specification with double line spacing is provided. The substitute specification is identical to the original specification except for correcting two typographical entries as note earlier. Also in order to provide an antecedent basis for the claimed subject matter, paragraph [0045] has been amended making the specification consistent with the claims. In this regard, a new sentence has been added at the end of paragraph [0045] which reads: "The thistle cloth 66, a layer of either hooks and piles, is secured to the bottom surface 63 for providing it with a textured decorated finish."

### **Informalities Re: Claim Markings:**

Response to the Office Action mailed June 14, 2005 attorney for applicant has provided a proper status identifier for claims 30 and 31 to indicate that such claims are new. Attorney for applicant has further changed the status identifier for claims 4, 19, and 20 from cancelled to withdrawn.

While attorney for applicant recognizes that the informalities addressed in the June 14, 2005 Office Action were caused by attorney for applicant, attorney for applicant vigorously objects to the examiner taking two months and 27 days (virtually 3-months) to issue an Office Action pointing out such informalities. This objection is raised particularly in view of the fact that applicant filed an electronic response to the

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Office Action of February 24, 2005, within twenty-four days of the Office Action, on March 18, 2005. This extraordinary delay by the examiner has resulted in applicant needing to remit a one-month extension fee of \$60.00. In this regard, attorney for applicant respectfully requests a refund of the extension fees submitted with this amendment.

### **Rejections**

#### **Double Patenting Rejection**

Claims 1, 5, 13 and 15-18 have been rejected on the judicially created doctrine of obvious double patenting over claims 1-12 of U.S. patent application No. 10/454,236 and 09/910,641. Responsive to this rejection, attorney for applicant(s) agrees upon receiving Notice of Allowability with respect to the present patent application, a terminal disclaimer in compliance with 37 CFR 1.32 (c). Accordingly claims 1, 5, 13, and 15-18 will be placed in condition for immediate allowance upon the filing of such a disclaimer. Attorney for applicant therefore respectfully requests that this rejection be withdrawn conditioned upon the receipt of the above-mentioned terminal disclaimer.

#### **Rejections Under 35 USC §102(b)**

Claims 1, 5, 13-18 have been rejected under 35 USC §102(b), as being anticipated by *Sullivan (U.S. 6, 255, 553)*. Claim 1 has been amended to render it more clear and definite, and to emphasize the patentable novelty thereof. In this regard, claim 1 as amended specifies amongst other things, as follows:

- "1. A novelty fashion wear item, comprising:
  - a flexible pad having a planar body engaging surface and an attachment engaging surface;
  - wherein said planar body engaging surface is coated throughout with reusable adhesive means for removably securing said pad to a body part; and

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wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles for providing said pad with a decorated textured finish."

Nowhere is this combination of elements and steps described in, nor suggested by the **Sullivan reference**.

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elec. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the **Sullivan reference**, which fails to show all of the essential elements of the instant invention.

The **Sullivan reference** describes a decorative bandage having a flexible backing 12 with an absorbent pad 34 disposed on one of its surface for direct contact with a body wound and therefore is void of adhesive on its wound-facing surface 36. A soft three-dimensional figure 26 is attached to its other surface for providing the bandage with a decorative appearance. In short, the wound facing surface of the backing is not completely coated with an adhesive but instead is provided with or obstructed with an absorbent pad to engage a wound thereby preventing the flexible backing 12 from contacting a body part throughout its entire surface area. Moreover, the 3

The novel features of the present invention are not disclosed, nor suggested by the **Sullivan reference** in that the **Sullivan reference** does not disclose, nor suggest a "a flexible pad having a planar body engaging surface and an attachment engaging

surface ...".

Secondly, the ***Sullivan reference*** does not teach, nor suggest, "wherein said planar body engaging surface is coated throughout with reusable adhesive means for removably securing said pad to a body part..."

Finally, the ***Sullivan reference*** does not suggest, nor disclose, "wherein said attachment engaging surface is covered throughout with a layer of either hooks or piles for providing said pad with a decorated textured finish."

Thus, while the ***Sullivan reference*** may teach a bandage having a backing with a wound protecting pad on one of its surfaces and a decorative attachment on the other one of its surfaces, the ***Sullivan reference*** does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claim 1 as amended, patentably distinguishes over the ***Sullivan reference***.

Claims 5,13-18 and 21 depend from claim 1 and therefore patentably distinguish over the ***Sullivan reference*** under the same rationale as set forth relative to claim 1.

### **Conclusion**

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

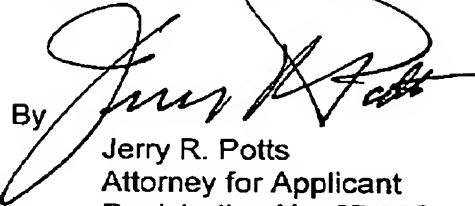
Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned

Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: June 17, 2005

Respectfully submitted,

Jerry R. Potts & Associates

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Jerry R. Potts  
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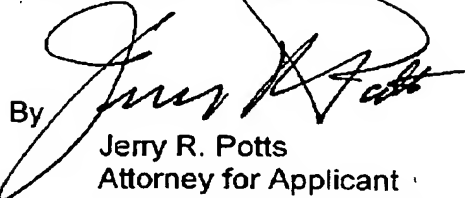
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